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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91239589
Party	Plaintiff Maker's Mark Distillery, Inc.
Correspondence Address	RICHARD M ASSMUS MAYER BROWN LLP PO BOX 2828 CHICAGO, IL 60690-2828 UNITED STATES Primary Email: dvirtue@mayerbrown.com Secondary Email(s): rassmus@mayerbrown.com , gbarcelona@mayerbrown.com , ipdocket@mayerbrown.com , michaeladams@mayerbrown.com 312-701-8623
Submission	Brief on Merits for Plaintiff
Filer's Name	Daniel P. Virtue
Filer's email	ipdocket@mayerbrown.com , rassmus@mayerbrown.com , michaeladams@mayerbrown.com , enash@mayerbrown.com , dvirtue@mayerbrown.com
Signature	/Daniel P. Virtue/
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**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

MAKER'S MARK DISTILLERY, INC.,

Opposer,

v.

BOWMAKER'S WHISKEY COMPANY,

Applicant.

Opposition No. 91239589

Serial No. 87,383,989

Mark: BOWMAKER'S WHISKEY

OPENING TRIAL BRIEF OF OPPOSER
MAKER'S MARK DISTILLERY, INC.

Michael D. Adams
Richard M. Assmus
Emily A. Nash
Daniel P. Virtue
MAYER BROWN LLP
P.O. Box 2828
Chicago, IL 60690-2828
(312) 701-8713

*Attorneys for Opposer Maker's Mark
Distillery, Inc.*

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Pursuant to 37 C.F.R. § 2.128 and TBMP § 801, Opposer Maker's Mark Distillery, Inc. ("Opposer" or "Maker's Mark") respectfully submits Opposer's Opening Trial Brief, requesting that the Board refuse registration of United States Application Serial No. 87,383,989 for the standard character mark BOWMAKER'S WHISKEY in class 33 for use in connection with "distilled spirits; whiskey; bourbon" (the "Contested Application") on the grounds that BOWMAKER'S WHISKEY is likely to be confused with Opposer's iconic trademarks MAKER'S MARK and MAKER'S, which have been used by Opposer for identical goods sold in the United States for more than 60 years.

I. INTRODUCTION

Opposer has been making and selling bourbon under the incontestable trademark MAKER'S MARK for more than 60 years and is widely regarded as an "icon" both in the spirits industry and in popular culture. Despite the prevailing legal authority's admonitions that newcomers give brands of this stature a wide berth when selecting their trademarks, Applicant, with full knowledge of the MAKER'S MARK brand, chose to adopt the dominant portion of Opposer's mark—MAKER'S—as well as text from the MAKER'S MARK website. Applicant now seeks to use its BOWMAKER'S brand for identical, directly competitive goods sold through identical sales channels. Maker's Mark respectfully submits that the Contested Application should be refused.

II. DESCRIPTION OF THE RECORD

In addition to the pleadings and the file of the Contested Application, the record consists of the following evidence submitted by the parties during their respective testimony periods:

A. Opposer's Evidence

1. Testimonial Declarations

- Testimonial Declaration of Maker's Mark's Senior Marketing Director, Nathalie Phillips, with Exhibits 1-10, October 30, 2020, 31 TTABVue (redacted public version) & 32 TTABVue (confidential portions of same) ("Phillips Decl.").
- Testimonial Declaration of Maker's Mark's Vice President of Finance, Mitch Wagner, with Exhibits 1-7, October 28, 2020, 35 TTABVue (redacted public version) & 33 TTABVue (confidential portions of same) ("Wagner Decl.").

2. Testimonial Deposition Transcripts

- Testimonial Deposition Transcript of Applicant's founder, Bryan Parks, with deposition exhibits, October 22, 2020, 39 TTABVue (redacted public version) and 40 TTABVue (confidential portions of same) ("Parks Trial Test.").
- Testimonial Deposition Transcript of Applicant's marketing consultant, Marcus Jenkins, with deposition exhibits, October 29, 2020, 39 TTABVue ("Jenkins Test.").
- Testimonial Deposition Transcript of attorney who filed the Contested Application on Applicant's behalf, Ruth Khalsa, with deposition exhibits, October 27, 2020, 39 TTABVue ("Khalsa Test.").
- Testimonial Deposition Transcript of Applicant's consultant Don Rodgers, with deposition exhibits, January 26, 2021, 47 TTABVue ("Rodgers Test.").

3. Opposer's Notices of Reliance

- Opposer's First Notice of Reliance with Exhibits 1-4, October 28, 2020, 26 TTABVue ("Opp. NOR 1")
 - Printouts from the USPTO database showing the status and title of Maker's Mark's pleaded registrations for the marks MAKER'S MARK, MAKER'S, MAKER'S 46, and MAKER'S MARK PRIVATE SELECT ("Opposer's Marks").
- Opposer's Second Notice of Reliance with Exhibit 5, October 29, 2020, 27 TTABVue (redacted public version) & 28 TTABVue (confidential) ("Opp. NOR 2")

- The July 24, 2019 discovery deposition transcript of Applicant’s founder, Bryan Parks, with deposition exhibits (“Parks Discovery Dep.”).
- Opposer’s Third Notice of Reliance with Exhibits 6-12, October 29, 2020, 29 TTABVue (“Opp. NOR 3”).
 - Applicant’s responses to Opposer’s discovery requests.
- Opposer’s Fourth Notice of Reliance with Exhibits 13-20, October 30, 2020, 30 TTABVue (“Opp. NOR 4”).
 - Newspaper articles, magazine articles, and other publications referencing (i) the strength of Opposer’s Marks, (ii) consumers’ widespread recognition of Opposer’s Marks, and (iii) Opposer’s longstanding use of Opposer’s Marks.
 - Copies of decisions issued by the Sixth Circuit Court of Appeals and the Western District of Kentucky acknowledging the strength, popularity, and widespread consumer recognition of MAKER’S MARK bourbon.
- Opposer’s Fifth Notice of Reliance with Exhibits 21-29, October 30, 2020, 34 TTABVue (“Opp. NOR 5”).
 - Printouts from retailer websites and restaurant drink menus indicating the price point of goods sold under Opposer’s Marks.
 - A printout of the National Archive record reflecting Maker’s Mark Distillery’s registration as a National Historic Landmark and an article from the Kentucky Distillers Association demonstrating the longevity, strength, and historical importance of the MAKER’S MARK brand.
 - Dictionary definition of “MAKER”.
 - Various webpages and advertisements.
- Opposer’s Sixth Notice of Reliance with Exhibits 30-42, February 12, 2021, 48 TTABVue (“Opp. NOR 6”).
 - Printouts from the USPTO database showing that the Contested Application is one of only two records not owned by Maker’s Mark for active applications and registrations in Class 33 that contain the word segment MAKERS in punctuated and non-punctuated form for the goods and services “whiskey,” “whisky” or “bourbon,” the other being

a registration for a design mark owned by an Italian wine company.

- Dictionary definitions of “BOURBON” and “PRIVATE BRAND”.
- Printouts from various Internet websites demonstrating the manner of use or non-use of third-party marks cited by Applicant.
- Printouts of Applicant’s Facebook and Twitter pages.

B. Applicant’s Evidence

1. Testimonial Declarations

- Testimonial Declaration of Applicant’s consultant Don Rodgers, December 28, 2020, 41 TTABVue (“Rodgers Decl.”).
- Testimonial Declaration of Applicant’s counsel in the instant opposition proceeding, Theodore Breiner, with Exhibits 87-95, December 29, 2020, 44 TTABVue (“Breiner Decl.”), which is subject to the evidentiary objections set forth in Exhibit A.

2. Applicant’s Notices of Reliance

- Applicant’s First Notice of Reliance with Exhibits 22-33, December 22, 2020, 36 TTABVue (“App. NOR 1”).
 - Opposer’s responses to Applicant’s discovery requests.
- Applicant’s Second Notice of Reliance with Exhibits 34-74, December 22, 2020, 37 TTABVue (“App. NOR 2”).
 - Dictionary definitions of “BOWMAKERS” and “MAKER’S MARK”.
 - Printouts from the USPTO database showing the status and title of various registrations and pending applications.
- Applicant’s Third Notice of Reliance with Exhibits 75-86, December 29, 2020, 43 TTABVue (“App. NOR 3”), subject to the evidentiary objections set forth in Exhibit A.
 - Printouts from the USPTO database showing the status and title of a registration.

- Printouts of various websites, articles, and results of Google searches allegedly performed.

C. Parties' Stipulation of Facts

- Stipulation dated December 22, 2020 whereby the parties acknowledge that Opposer's Marks would have been among the 328 trademarks included in the results of the examining attorney's search criteria during review of the Contested Application. 38 TTABVue (the "Search Stipulation").

III. STATEMENT OF THE ISSUE

This matter raises the following issue: whether, in light of: (i) the great strength and fame of Opposer's MAKER'S MARK trademark, as acknowledged by Applicant's own consultant and founder,¹ (ii) consumers' widespread recognition not only of the MAKER'S MARK trademark, but of the Opposer's MAKER'S trademark, as acknowledged by Applicant's own consultant,² (iii) the conceptual strength of the MAKER'S MARK trademark, (iv) the evident similarities between MAKER'S MARK and MAKER'S, on the one hand, and BOWMAKER'S, on the other, (v) the identical nature of the parties' claimed goods, (vi) the identical channels-of-trade for the parties' claimed goods, and (vii) the fact that goods bearing the parties' marks are frequently ordered orally in restaurants and bars where confusion is even more likely to occur, Applicant's mark BOWMAKER'S WHISKEY should be refused registration on the grounds that it is likely to cause confusion with Opposer's Marks pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), and under the test set forth by *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

¹ See *Rodgers Test*, at 44:14-22 ("Q: [W]ould you call [Maker's Mark] a famous brand? A: Yes.") and 18:14 ("Everybody knows Maker's Mark"), 47 TTABVue; Parks Trial Test 51:16-22, 39 TTABVue (acknowledging MAKER'S MARK brand is one of the best-known brands of bourbon in the United States).

² *Rodgers Test*, at 41:11-42:2 ("Q: What do you think are the leading bourbon brands in the United States? . . . A: Beam, Knob Creek, Jack Daniels, Maker's. Those are the biggies. Q: And when you say Maker's, you mean Maker's Mark? A: Yes, Maker's Mark."), 47 TTABVue.

IV. RECITATION OF THE FACTS

A. The Parties' Identical Competitive Goods

Bourbon is a type of whiskey that meets a special standard based on its ingredients and how it is fermented, distilled, and aged. Wagner Decl. ¶5; Opp. NOR 6 Ex. 36; 27 C.F.R. § 5.22(b)(1)(i). Bourbon falls within class 33 and the Contested Application, filed on an intent-to-use basis, is for registration of “distilled spirits; whiskey; bourbon” in class 33.

Opposer's Marks are all registered in class 33 and Opposer's covered goods include identical goods to those cited in the Contested Application, namely, “whiskey” (Opp. NOR 1, Ex. 1), “distilled spirits; liquor” (Opp. NOR 1, Ex. 2), “alcoholic beverages except beers; whisky” (Opp. NOR 1, Ex. 3), and “alcoholic beverages except beers; whisky” (Opp. NOR 1, Ex. 4). Opposer's Marks are also used and registered for ancillary goods and services, including “steak sauce,” “writing instruments,” “flasks, glassware for beverages, mugs,” “clothing, namely, hats, jackets, pullovers, t-shirts, sweatshirts and vests,” “chocolates,” “fruits preserved in alcohol,” “sauces,” and “bar and restaurant services.”

Opposer's bourbon products bearing Opposer's Marks are widely sold in locations that include (i) at brick-and-mortar retail locations, both national and regional, such as liquor stores, grocery stores, and big-box chains, (ii) at bars, pubs, restaurants, and hotels, (iii) at the Maker's Mark Distillery gift shop in Loretto, Kentucky, (iv) at catering venues, and (v) through e-commerce, which includes third-party retailer websites such as Binny's, Total Wine & More, The Whiskey Exchange, and TheDrinkShop, as well as the Maker's Mark website, which drives sales online by directing customers to local e-commerce delivery vendors such as Drizly. Wagner Decl. ¶17. Applicant's bourbon products bearing BOWMAKER'S are similarly intended to be sold in liquor stores and at bars and restaurants, categories that overlap with Opposer's sales channels. Parks Trial Test 17:21-18:10.

All bourbon sales are competitive, as sales will be made through overlapping channels whether the bourbon is a “craft” product made by an independent distiller with limited production quantities like the Applicant’s or a bourbon that is made by a larger, more widely available brand like MAKER’S MARK. Phillips Decl. ¶¶14-18. The breadth and reach of Opposer’s distribution of MAKER’S branded products and Opposer’s reputation for maintaining superior craftsmanship despite its high degree of commercial success are strong indicators that the parties’ identical goods are directly competitive. Wagner Decl. ¶¶23-25; Phillips Decl. ¶16.

Furthermore, Opposer’s MAKER’S MARK bourbon is consumed on premise (*e.g.*, in a bar or restaurant where Applicant also intends to sell its products) approximately 40% of the time. Phillips Decl. ¶27, Phillips Decl. Ex. 1. This means that a great number of the parties’ directly competitive sales will be made in bars and restaurants where courts have concluded that oral ordering makes confusion more likely.³

B. History of Maker’s Mark Distillery and its MAKER’S Bourbons and Registrations

Opposer’s MAKER’S MARK bourbon is one of the most well-recognized—if not the most well-recognized—bourbon brands in the United States. Phillips Decl. ¶33; Rodgers Test. 41:11-23. Bourbon represents 42% of whiskey consumed in the United States and MAKER’S MARK has consistently held a top-3 or top-4 spot in brand power for all whiskies in the United States (inclusive of flavored, Irish, and other whiskey varieties). Phillips Decl. ¶27, Phillips Decl. Ex. 1. At least 69% of consumers are aware of Opposer’s MAKER’S MARK brand, and Applicant’s own consultant has acknowledged that the MAKER’S MARK brand is a famous one that “everybody” knows. Phillips Decl. ¶27, Phillips Decl. Ex. 1; Rodgers Test. 44:14-22 and 18:14. Applicant’s

³ See *Schieffelin & Co. v. The Molson Companies Ltd.*, 9 U.S.P.Q.2d 2069, 2073 (TTAB 1989) (finding likelihood of confusion enhanced where, as here, “the products of the parties are of the type ordered verbally [orally] in bars and restaurants.”).

founder Mr. Parks also provided testimony acknowledging that the MAKER'S MARK brand is one of the best-known brands of bourbon in the United States. Parks Trial Test 51:16-22.

On November 8, 1957, Opposer applied to register MAKER'S MARK in class 33 for "whiskey". Opp. NOR 1, Ex. 1, 26 TTABVue. The MAKER'S MARK trademark registered on May 5, 1959 and became incontestable on May 20, 1964. *Id.* The incontestable MAKER'S MARK registration claims first use in U.S. commerce as of November 1, 1957. *Id.*

The trademark MAKER'S MARK was selected and adopted by Maker's Mark Distillery's founder, Bill Samuels, Sr., and his wife, Margie Samuels, and inspired by the unique imprints used by pewter craftsmen. Responses to Applicant's Interrogatory Nos. 1-2, App. NOR 1, Ex. 23. Consistent with the first use date claimed on the application and the specimens and declarations of use filed in connection with maintaining this registration ever since, Opposer has been selling its bourbon whiskey continuously throughout the United States under the MAKER'S MARK trademark since the 1950s. Wagner Decl. ¶6; Opp. NOR 1 Ex. 1.

As shown below, as early as February 14, 1959, Maker's Mark was placing full-page ads in nationally distributed publications prominently featuring the MAKER'S MARK trademark.



Wagner Decl. ¶9, Wagner Decl. Ex. 3, 35 TTABVue.

Opposer has continued its ambitious advertising of MAKER'S MARK ever since, with ads appearing in prominent locations in print, online, on television, through social media, on billboards, and in point of sale displays, as exemplified below. Wagner Decl. ¶7, Wagner Decl. Ex. 1, 35 TTABVue.



Confidential

MAKER'S0002699





Confidential

MAKER'S0002845



Confidential

MAKER'S0002852



Confidential

MAKER'S0003005



Confidential

MAKER'S0003053

Wagner Decl. Ex. 1, 35 TTABVue.



Phillips Decl. ¶58.



4



5

Opposer has historically spent sizeable sums of money on advertising to stay top-of-mind with its current and prospective customers. Phillips Decl. ¶15. For example, [REDACTED]

[REDACTED]

[REDACTED] Phillips Decl.

¶46-47, Phillips Decl. Ex. 8.

Throughout the years, Opposer has been recognized for the quality of its bourbon as well as its “superior” and “savvy” marketing. Opp. NOR 4 Exs. 13-14, 30 TTABVue. Examples of these accolades include:

- An August 1980 article about Maker’s Mark that appeared on the front page of *The Wall Street Journal*, where one observer noted that, by that point, the brand had already established “superior quality with a fine image” and was “a textbook case of superior marketing.” Opp. NOR 4, Ex. 14, 30 TTABVue.
- Remarks by Audrey Saunders, a master mixologist and beverage director at New York’s famed Carlyle Hotel, who said the following in 2004: “Maker’s Mark is an

⁴ <https://www.facebook.com/makersmark/photos/pcb.10157679035653334/10157679035553334/>

⁵ <https://www.facebook.com/makersmark/photos/pcb.10158919833333334/10158919833163334/>

incredible bourbon that created and defined the premium bourbon category. Fifty years of fine craftsmanship opened the door for newer entities. But without Maker's Mark, bourbon would still be seen as a cheap drink for those who cared little or nothing for taste. Maker's Mark is in a class by itself and is the perfect spirit for bourbon novices and aficionados alike, as well as for those who seek an ideal accompaniment to a fine meal." Opp. NOR 4, Ex. 18, 34 TTABVue.

- Remarks in a 2004 article in *The Associated Press* where the publisher of a beverage trade journal said Maker's Mark's founder, Bill Samuels, Sr., "single-handedly created the fine bourbon category" and another beverage industry consultant and educator remarked that the brand is so versatile that "[y]ou can't run a bar without Maker's". Opp. NOR 4, Ex. 16, 30 TTABVue.
- A November 2018 article in *Food & Wine* magazine calling MAKER'S MARK the #1 most important bourbon ever made, noting that it was "[t]he clear choice for the top spot" among those polled in its survey and observing that "more than any other brand, [Maker's Mark] helped ignite the bourbon renaissance we all enjoy today". Opp. NOR 4, Ex. 13, 30 TTABVue.
- Honors for 1st Place in the "Best Bourbon Whiskey" category of the International Whiskey Competition in 2019. Phillips Decl. ¶31; Phillips Decl. Ex. 4.

Applicant's own witnesses have also acknowledged the strength and reputation of the MAKER'S MARK brand and the family that started Maker's Mark Distillery. For example:

- Applicant's consultant Don Rodgers testified that "everybody knows Maker's Mark" and that the MAKER'S MARK brand is famous. Rodgers Test. 18:14; 44:14-22, 47 TTABVue.

- Applicant's founder Bryan Parks testified that the MAKER'S MARK brand is one of the best-known brands of bourbon in the United States. Parks Trial Test 51:16-22.
- Applicant's founder Bryan Parks had his photo taken with Bill Samuels, Jr., the son of Maker's Mark Distillery's founder and the company's former president and CEO, during a distiller's course Mr. Parks took in Louisville, Kentucky that included a session on brand development. Parks Trial Test. 11:5-14:25. Mr. Parks testified that he had his photo taken with Mr. Samuels as a "souvenir" because he considers Mr. Samuels to be "famous" and a "celebrity". Parks Trial Test 87:6-13.

The MAKER'S MARK brand has a loyal following across broad swaths of the American consuming public. For example:

- 42% of readers surveyed in an online poll by *Dayton Business Journal* in 2013 picked MAKER'S MARK as their favorite bourbon brand, with the second place finisher garnering less than half the votes MAKER'S MARK received. Opp. NOR 4, Ex. 15, 30 TTABVue.
- While MAKER'S MARK's core drinkers are males ages 40-59, the brand is evenly positioned across males and females and is viewed as a high quality/premium entry brand for new consumers, as it embodies the quality and craftsmanship of small production bourbon brands but at a lower price point. Phillips Decl. Ex. 1.
- This versatility has allowed the brand to develop a strong following among young adults as well. Opp. NOR 4, Ex. 16.
- Opposer's Facebook page for MAKER'S MARK, www.facebook.com/makersmark, had over 839,000 likes and over 817,000

followers as of October 21, 2020, and Opposer's Twitter account for MAKER'S MARK, www.twitter.com/makersmark, has over 133,000 followers. Phillips Decl. ¶34, Phillips Decl. Ex. 5, 31 TTABVue.

- Thousands of individuals of all ages have eagerly signed up as "Brand Ambassadors" for MAKER'S MARK in a unique and ambitious grassroots marketing initiative. Wagner Decl. ¶20.

According to figures from the Distilled Spirits Council of the U.S. cited in *Business Wire*, in 2004 MAKER'S MARK had a 77% share of the U.S. fine bourbon market. Opp. NOR 4, Ex. 18, 30 TTABVue. Sales of MAKER'S MARK bourbon have steadily increased year after year.

[REDACTED]

[REDACTED] Wagner Decl. ¶14, Wagner Decl. Ex. 6, 35 TTABVue. In April 2020, *Forbes* reported MAKER'S MARK bourbon was one of the top two bestselling bourbon brands on e-commerce site Drizly.com, a website popular with millennials ages 23-38 and GenX-ers ages 39-54. Opp. NOR 4, Ex. 19, 30 TTABVue.

Despite its great commercial success, MAKER'S MARK bourbon is so popular that at various times there has not been enough product available to meet customer demand, forcing the company to ration or "allocate" its available stock to its customers. Phillips Decl. ¶17.

For years, consumers have used the name MAKER'S as shorthand for MAKER'S MARK. Wagner Decl. ¶10. Over time, MAKER'S has become a quick, easy, and more casual way of referring to MAKER'S MARK bourbon, just as BUD has become a more casual way of referring to the BUDWEISER brand of beer. Wagner Decl. ¶10. For example, when consumers go to a bar or restaurant and want to select a MAKER'S MARK bourbon, they frequently ask for

MAKER'S. This is known as the brand's "bar call," and it is an important aspect of how consumers utilize Opposer's trademarks at the point of purchase. Wagner Decl. ¶10.

Applicant's witnesses have acknowledged that "MAKER'S" is routinely used as shorthand for bourbon products sold by the Opposer. For example:

- Applicant's consultant Don Rodgers used MAKER'S as shorthand when calling MAKER'S MARK one of the leading bourbon brands in the United States:

Q: What do you think are the leading bourbon brands in the United States?

...

A: Beam, Knob Creek, Jack Daniels, Maker's. Those are the biggies.

Q: And when you say Maker's, you mean Maker's Mark?

A: Yes, Maker's Mark.

Rodgers Test. 41:11-23, 47 TTABVue.

- Mr. Rodgers similarly did not hesitate when asked about the MAKER'S MARK brand's bar call.

Q: If I showed up at a bar in Frankfort, Kentucky, and asked for a Maker's, what would they give me?

A: Maker's Mark.

Rodgers Test. 41:24-42:2, 47 TTABVue.

- Applicant's founder, Mr. Parks, also affirmed that Opposer is the single source of goods for any product referred to as "MAKER'S" in a bar, one of the places where bourbon is most commonly sold.

Q: And if I ordered a Maker's on the rocks at a bar, what would they give me?

...

A: There are several out there. . . they'd probably ask for clarification.

...

Q: What clarification do you think they'd ask for if I asked for a Maker's on the rocks at a bar?


A: *[I]t would depend on what varieties of Maker's Mark they carry on the shelf.*

Parks Trial Test 52:22-53:16.

The testimony of Opposer's Vice President of Finance, Mitch Wagner, and Senior Marketing Director, Nathalie Phillips, is consistent with the testimony of Applicant's witnesses on this subject.

Mr. Wagner is a 25-year veteran of Maker's Mark. As Vice President of Finance for Opposer, Mr. Wagner oversees financial records, such as revenue and profitability, for the family of Maker's Mark's products. Wagner Decl. ¶1-2. Ms. Phillips is a marketing professional with nearly 10 years of experience developing and executing brand strategy for whiskey and creating and bringing to market new brands of whiskey. Prior to working for Opposer and its parent company, Beam Suntory Inc., Ms. Phillips was Brand Manager for Fine Whisky and later Flavored Whiskeys at a competitor company, Campari America, and worked in bourbon and whiskey sales at a wine and spirits distribution company. Phillips Decl. ¶1-7.

Both Ms. Phillips and Mr. Wagner testified that they are not aware of any company besides Maker's Mark that currently offers bourbon for sale in the United States using the term "MAKER" or "MAKER'S" in its name. Phillips Decl. ¶60; Wagner Decl. ¶26.

Moreover, apart from the application for BOWMAKER'S WHISKEY that is the subject of this opposition and U.S. Reg. No. 5425594 for the mark  (SENSI FAMILY OF WINEMAKERS SINCE 1890 LUXURY EDITION & design), every active application and registration in class 33 that contains the word segment MAKERS in punctuated and non-

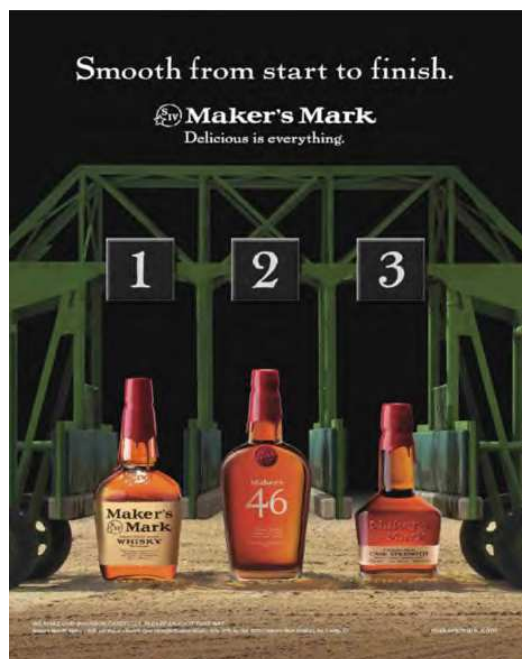
punctuated form containing the goods and services “whiskey,” “whisky” and “bourbon” is owned by the Opposer. Opp. NOR 6 ¶¶1-7, Exs. 30-34.⁶

In 2015, Opposer obtained a registration for MAKER’S in Class 33 for “alcoholic beverages except beers; whisky.” Opp. NOR 1, Ex. 2, 26 TTABVue. As Mr. Parks noted in his deposition, Opposer has even developed brand extensions using the term MAKER’S. Parks Trial Test 52:22-53:16; Wagner Decl. ¶¶11. These include MAKER’S 46, which it started selling on or about 2010 and applied to register in 2010, MAKER’S MARK PRIVATE SELECT, which it applied to register in 2015, and MAKER’S MARK CASK STRENGTH. Opp. NOR 1, Exs. 2 and 4; Phillips Decl. ¶¶13.

These brand extensions have been advertised alone and alongside MAKER’S MARK.

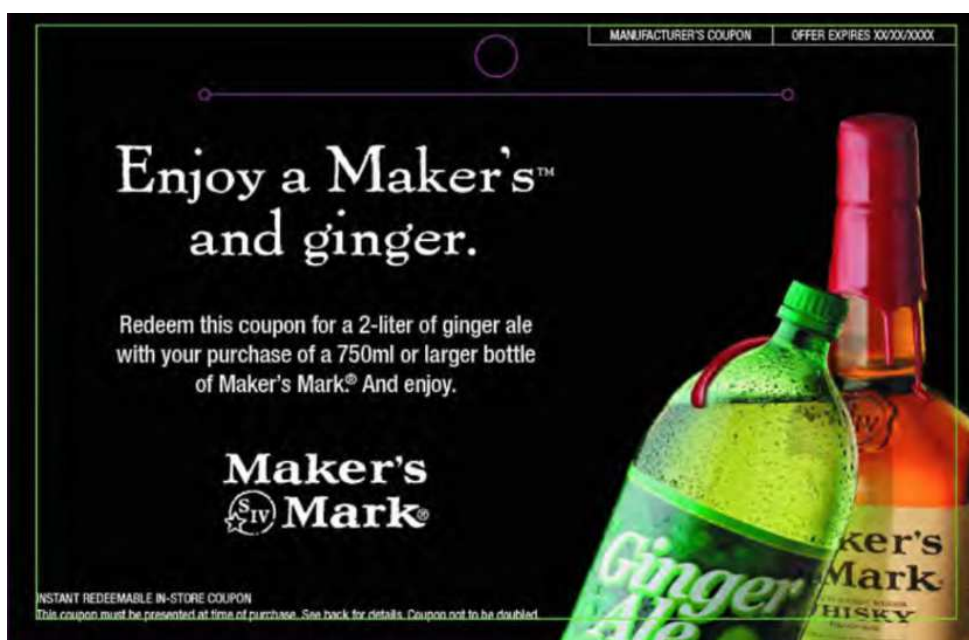


⁶ The owner of U.S. Reg. No. 5425594 is an Italian winemaker whose product offerings are limited to wines. Opp. NOR 6 ¶¶8, Ex. 35.

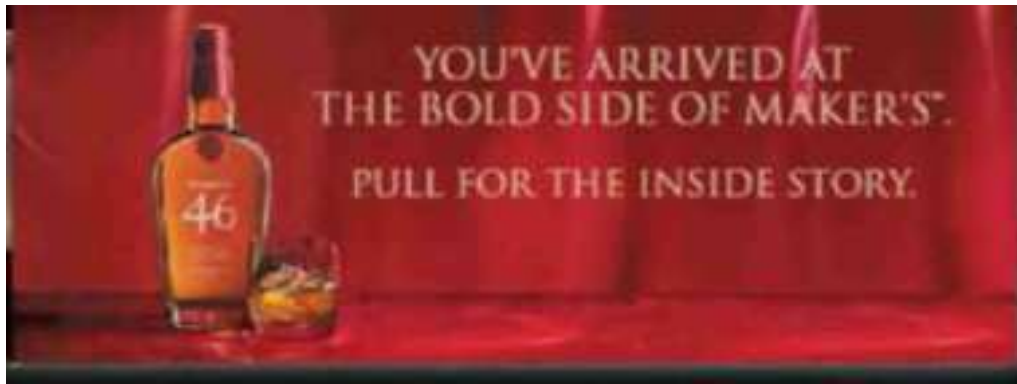


Wagner Decl. Ex. 1.

Recognizing the strength of the MAKER'S trademark, Opposer has featured MAKER'S as a standalone term in recent ad campaigns including "ENJOY A MAKER'S AND GINGER" and "THE BOLD SIDE OF MAKER'S". Wagner Decl. ¶¶12-13.



Wagner Decl. Ex. 5, 35 TTABVue.



Wagner Decl. Ex. 4, 35 TTABVue.

Maker's Mark is also a pioneer of bourbon tourism. Each year, many thousands of people travel to Loretto, Kentucky, to visit Maker's Mark's distillery, which was designated a National Historic Landmark on January 25, 1980. Wagner Decl. ¶19; Opp. NOR 5 Ex. 25. In making this designation more than 40 years ago, the U.S. Secretary for the Department of the Interior noted that the distillery (i) "possesses national significance in illustrating the history of the United States," (ii) "represents the evolution of bourbon from a relatively crude beverage . . . into a quality distillate recognized and readily accepted all over the world," and is (iii) "[a] significant example of our Nation's cultural heritage for the education and enjoyment of all our citizens." Opp. NOR 5 Ex. 25. Maker's Mark's distillery was the first in America to achieve historic landmark status and has been decreed the world's "oldest operating bourbon whisky distillery" by *Guinness World Records*. Opp. NOR 5, Ex. 26, 34 TTABVue. The distillery is a focal point for visitors to the Louisville, Kentucky area and has won the prestigious "Icons of Whisky Visitor Attraction of the Year" at least three times, twice back-to-back in the years immediately preceding Applicant's filing of the Contested Application. Opp. NOR 4, Ex. 17, 30 TTABVue; Phillips Decl. ¶32, 31 TTABVue.

As noted by the Kentucky Distillers Association in January 2011, the MAKER'S MARK brand has transformed from a "Kentucky 'cult' bourbon into 'a national icon'". *Id.*

C. Newcomer Bowmaker's Whiskey Company

Applicant Bowmaker's Whiskey Company was incorporated on November 28, 2016, in Schoolcraft, Michigan by its sole owner, Bryan Parks. The company owns a warehouse located in Lake City, Michigan, where the Applicant is currently aging barrels of bourbon and other spirits and a tasting room that is currently under construction in downtown Lake City, Michigan. Parks Trial Test 15:16-16:13, 18:20-24.

Prior to establishing Bowmaker's Whiskey Company, Mr. Parks attended a distiller's course at Moonshine University in Louisville Kentucky from October 18-23, 2015. Parks Trial Test 11:7-12:25. While at Moonshine University, Mr. Parks took a course on "brand development". Parks Trial Test 13:4-6; Maker's Mark Trial Ex. 1.

As part of Moonshine University, Mr. Parks attended a speech given by Bill Samuels, Jr., the former president and CEO of Maker's Mark Distillery. Parks Trial Test 13:16-14:25. Mr. Parks went out of his way to talk with Mr. Samuels and have his picture taken with him because he was a fan of Mr. Samuels, who he said was "famous" and called a "celebrity". Parks Trial Test 13:16-14:25; Parks Trial Test 87:6-13.

Upon returning from Moonshine University, Mr. Parks began planning in earnest to produce and sell bourbon. Parks Trial Test 68:24-69:13. He hired several consultants, including a marketing and web consultant named Marcus Jenkins, a consultant for "the whiskey industry in general" named Don Rodgers, and a consultant to assist in filing the requisite paperwork with the Alcohol and Tobacco Tax and Trade Bureau (the "TTB"). Parks Trial Test 20:4-21:9. At trial, Mr. Parks also testified that he had very recently hired a distributor. Parks Trial Test 22:23-23:19. When Opposer requested a copy of the distribution agreement, Applicant refused. After much back

and forth, Opposer agreed to withdraw the request so long as Applicant provided detailed information regarding the identity of the new distributor, such as name and company affiliation, and the geographic territory for the distribution of Applicant's goods in the distribution contract. Applicant maintained its refusal to provide identifying information, noting in a December 29, 2020, email from counsel only that the territory of distribution is "Michigan" and stating that the requested information, is "commercially sensitive" and "not necessary to [Opposer's] case."

At trial, in addition to Mr. Parks, testimony was taken from Mr. Jenkins, Mr. Rodgers, and Ruth Khalsa, the attorney of record who filed the Contested Application. *See* 39 TTABVue (Jenkins and Khalsa); 47 TTABVue (Rodgers).

Mr. Jenkins testified that upon being hired in the fall of 2016, he and his graphic design business, IDEED, assisted Mr. Parks in doing the following for Bowmaker's Whiskey Company: (i) preparing a business plan, (ii) designing labels, (iii) creating and maintaining both a website and social media accounts for the company, and (iv) searching and filing a trademark application for BOWMAKER'S WHISKEY in the United States. Jenkins Test. 42:6-22, 33:9-10, 44:23-46:10.

With respect to the trademark, Mr. Jenkins testified that he and Mr. Parks went to a "trademark company" called Trademarkia's website, entered the name "Bowmaker's Whiskey" and concluded that the mark BOWMAKER'S WHISKEY was available to the Applicant. *Id.* at 26:10-27:9. Mr. Jenkins became the point of contact for the Contested Application, working with a Trademarkia-affiliated law firm to apply to register the mark on the Applicant's behalf. *Id.* at 12:2-10.

Trademarkia is a website that "funnel[s]" people requesting trademark representation to Raj Abhyanker, P.C. d/b/a LegalForce ("Legal Force"). Khalsa Test. 36:9-37:11. Mr. Abhyanker is the owner of the Trademarkia website and of LegalForce, which has an affiliate located in India

that handles “clerical” work for LegalForce and which is not, to Ms. Khalsa’s knowledge, a law firm. *Id.* at 43:1-18; 45:25-46:8.

Among the “clerical” work performed by this overseas affiliate in connection with the Contested Application were: (i) the performance of a clearance search for the subject mark, the results of which did not identify any of Opposer’s Marks despite Opposer’s high profile in the spirits industry and the parties’ common use of the term MAKER’S, and (ii) the preparation of the application itself for Ms. Khalsa’s signature through TEAS. *Id.* at 50:6-14; 45:14-17. None of the individuals who performed the alleged clearance search were U.S. trained or qualified attorneys and none were employed under the supervision of Ms. Khalsa. She was merely “permitted to interact” with them. 50:6-14; *Id.* at 35:14-23.

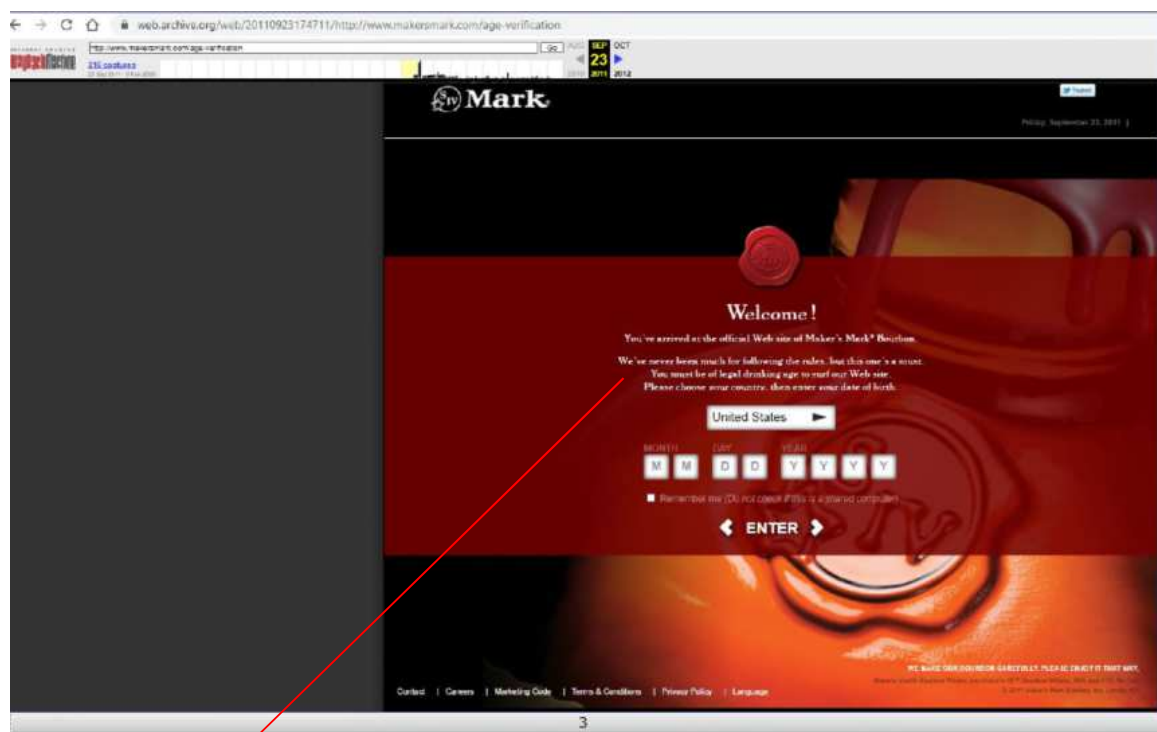
Non-attorney clericals overseas also determined whether there were any potential client conflicts in connection with the representation and whether any marks found in the course of their search warranted attorney review for potential likelihood of confusion, not by Ms. Khalsa, but by another attorney employed overseas by the Indian affiliate. *Id.* at 50:6-55:8. In her own words, Ms. Khalsa was not responsible for “making sure the India folks did the searches correctly.” Rather, she was “only in charge of making sure the [pre-populated] application [to register the trademark] was filed correctly.” *Id.* at 74:6-9. Even after the Opposer issued a cease and desist letter, the Applicant was notified of the cease and desist by a non-attorney and the initial response to the cease and desist was made by a non-attorney. *Id.* at 56:7-20; 58:9-15.

D. Bowmaker’s Copying of Maker’s Mark’s Web Content

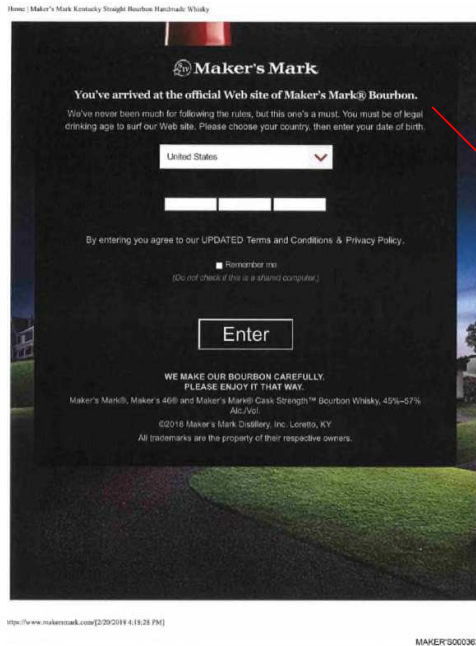
As noted above, Mr. Jenkins also assisted Mr. Parks in creating and maintaining a website and social media accounts for Bowmaker’s Whiskey Company. Jenkins Test. 14:4-21. In researching what to include on the website, Mr. Parks sat down with Mr. Jenkins and pulled up the websites of various whiskey and bourbon companies, including the Opposer’s. *Id.* at 66:11-68:22,

Applicant's Testimony Ex. 20. In early 2017, Mr. Parks, assisted by Mr. Jenkins, created <bowmakerswhiskey.com> and both a Facebook and Twitter account for Bowmaker's Whiskey Company. *Id.* at 14:4-21.

Opposer's website, <makersmark.com>, includes a responsibility statement, which Opposer has used since at least 2011. It reads in part: "We've never been much for following the rules but this one's a must" and "We make our bourbon carefully, please enjoy it that way." Phillips Decl. ¶¶40-41, Phillips Decl.Ex. 7.

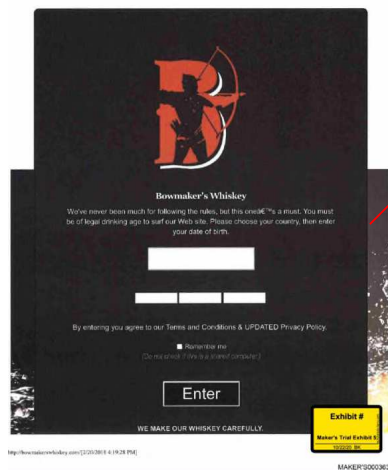


We've never been much for following the rules, but this one's a must.
You must be of legal drinking age to surf our Web site.
Please choose your country, then enter your date of birth.



You've arrived at the official Web site of Maker's Mark® Bourbon.
We've never been much for following the rules, but this one's a must. You must be of legal drinking age to surf our Web site. Please choose your country, then enter your date of birth.

Mr. Jenkins acknowledges copying the text “We’ve never been much for following the rules but this one’s a must” from the Maker’s Mark website and including it on the website his company created for the Applicant. Jenkins Test. 69:22-70:24. Although hesitating about whether the wording “we make our whiskey carefully” was copied from Maker’s Mark, he eventually admitted that the language from the Maker’s Mark website also appears on both parties’ pages. Jenkins Test. 94:6-11.



Bowmaker's Whiskey
We've never been much for following the rules, but this one's a must. You must be of legal drinking age to surf our Web site. Please choose your country, then enter your date of birth.

Jenkins Test. Ex 5.

E. The Contested Application and Instant Proceeding

On March 24, 2017, Applicant filed an application in class 33 to register the mark BOWMAKER'S WHISKEY on an intent-to-use basis for use in connection with "distilled spirits; whiskey; bourbon". The term WHISKEY was later disclaimed.

On February 20, 2018, Opposer filed a timely Notice of Opposition.

Prior to furnishing any discovery to Opposer, Applicant filed a motion for summary judgment. 10 TTABVue. In its brief in support of the motion, Applicant conceded that "the parties' goods are the same, the proximity of the goods in the market place, the same channels of trade, priority of use and the MAKER'S MARK trademark is well-known and will travel in the same channels of trade" and argued that the opposition should be dismissed solely on the grounds that the parties' marks are allegedly too dissimilar in sight, sound and meaning to result in a likelihood of confusion. *Id.* at 8. The motion was denied, discovery was completed and a trial followed. 24 TTABVue.

During testimony at trial, it became evident that there were certain documents responsive to Opposer's discovery requests that had not been produced, namely, communications with Mr. Rodgers and Mr. Jenkins and information regarding Applicant's distributors. Despite requesting these documents and following up on those requests, they were never furnished to Opposer.

V. ARGUMENT

A. Opposer Has Standing and Priority

To establish standing, Opposer must prove it has a real interest in the outcome of the proceeding and a reasonable basis for its belief that it will be damaged by issuance of the subject application. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999). Standing may be established by making of record copies of Opposer's pleaded registrations showing the current status of the registrations and their ownership.

Cunningham, 222 F. 3d at 945; *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1586 (TTAB 2008). Here, Opposer's claims are based upon current ownership of valid and subsisting registrations made of record at trial.⁷ Two of Opposer's Marks, for its flagship MAKER'S MARK trademark and MAKER'S trademark, were first used in commerce as early as November 1, 1957.⁸ Given Applicant filed the Contested Application on an intent-to-use basis on March 24, 2017, Opposer's pleaded registrations are clearly sufficient to establish Opposer's priority of use and standing in this proceeding.

B. Applicant's BOWMAKER'S WHISKEY Mark is Likely to Cause Confusion

Under *DuPont*, 476 F.2d at 1361, there are 13 factors the Board may consider in determining whether confusion between marks under Section 2(d) is likely to occur. However, in any given case, some of the *DuPont* factors may be more relevant than others. *See, e.g., Nike, Inc. v. Maher, et al.*, 100 U.S.P.Q.2d 1018, 1021 (TTAB 2011). In this proceeding, the relevant *DuPont* factors include:

Factor 5—Strength and fame of the senior mark(s)

Factor 1—Similarity of the parties' marks

Factor 2—Similarity of the goods

Factor 3—Similarity of the trade channels

Factor 4—Conditions under which sales of the covered goods are made

Factor 6—Number and nature of similar marks in use on similar goods; and

Factor 13—Other established fact probative of the effect of use, namely, Applicant's verbatim copying of Opposer's original content on Applicant's own website and social media pages. *DuPont*, 476 F.2d at 1361. To the extent there is any doubt as to likelihood of confusion,

⁷ *See* Opp. NOR 1, Exs. 1-4, 26 TTABVue.

⁸ *See* Opp. NOR 1, Exs. 1 and 2, 26 TTABVue.

such doubt must be resolved in favor of Maker's Mark, the registrant and prior user. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974).

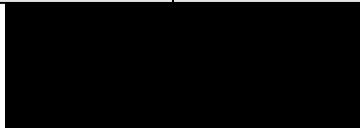
1. Opposer's Marks are Exceedingly Strong—Indeed Famous—And Should Be Afforded Broad Protection

“Famous or strong marks enjoy a wide latitude of legal protection” and cast “a long shadow which competitors must avoid.” *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992). This is particularly true where, as here, a newcomer seeks to use a similar trademark for competitive goods. As the Federal Circuit has observed on more than one occasion, “[t]here is no excuse for even approaching the well-known trademark of a competitor”. *Nina Ricci, S.A.R.L. v. E.T.F. Enters.*, 889 F.2d 1070, 1073 (Fed.Cir.1989) (internal quotations omitted). “[T]o do so raises ‘but one inference—that of gaining advantage from the wide reputation established by appellant in the goods bearing its mark[.]’” *Specialty Brands, Inc. v. Coffee Bean Distributors., Inc.*, 748 F.2d 669, 676, 223 USPQ 1281, 1285 (Fed. Cir. 1984) (quoting *Planters Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 924, 134 USPQ 504, 511 (CCPA 1962)).

The fame or strength of a mark is determined by a variety of factors, including the length of time the mark has been in use, the volume of sales under the mark, and the extent of advertising or promotion of the goods or services with which the mark is used. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 394 (Fed. Cir. 1983); *Apple Comp. v. TVNET.net, Inc.*, 90 U.S.P.Q.2d 1393, n. 6 (TTAB 2007). Opposer has established overwhelming evidence in support of each factor tending to show fame and great strength and is entitled to the wide scope of protection very strong marks are guaranteed under applicable law. Applicant's own consultant has even acknowledged that Opposer's MAKER'S MARK trademark merits this

elevated degree of protection, calling MAKER’S MARK a famous brand and saying that “everybody” knows it. Rodgers Test. 44:14-22 and 18:14, 47 TTABVue.

Below is a table summarizing the indicia of fame for Opposer’s Marks as compared with the relevant indicia of other marks at the time they were found to be famous by the Board or its reviewing court.⁹

Case Name	Mark	Length of Use of Mark	Sales Revenue	Marketing / Advertising Expenditures
<i>Maker’s Mark v. Bowmaker’s Whiskey Company</i>	MAKER’S MARK MAKER’S (bourbon / whiskey)	59 years		
<i>Bose Corp. v. QSC Audio Prods., Inc.</i> , 293 F.3d 1367, 1371-72 (Fed. Cir. 2002)	ACCOUSTIC WAVE WAVE (both deemed famous for speaker systems)	17 years	\$50 million (annual)	\$5 million (annual)
<i>Nike, Inc. v. Maher, et al.</i> , 100 U.S.P.Q. 2d 1018, 1026 (T.T.A.B. 2011)	JUST DO IT (deemed famous for apparel / shoes)	20 years	\$175 million (annual)	\$6 billion total, which would average \$300 million annually
<i>Nat’l Pork Bd., et al. v. Supreme Lobster and Seafood Co.</i> , 96 U.S.P.Q. 2d 1479, 1495-96 (T.T.A.B. 2010)	THE OTHER WHITE MEAT (deemed famous for pork products)	20 years	N/A	\$25 million (annual)

⁹ Figures for MAKER’S MARK are as of 2016, the last full year prior to Applicant filing the Contested Application.

- a. Opposer's MAKER'S MARK and MAKER'S Trademarks Have Been Used Consistently Without Interruption for More Than 60 Years

As early as February 14, 1959, Maker's Mark was selling full-page ads in nationally distributed publications prominently featuring the MAKER'S MARK trademark. Opp. NOR 5, Ex. 29, 34 TTABVue. Since the 1950s, Opposer has been selling bourbon—without interruption—under the MAKER'S MARK trademark. Wagner Decl. ¶6.

- b. MAKER'S MARK Occupies a "Central Place" in U.S. History and in the Minds of U.S. Consumers

The MAKER'S MARK brand "occupies a central place in the modern story of bourbon." *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 679 F.3d 410, 416, 102 USPQ2d 1693, 1696 (6th Cir. 2012). Opp. NOR 4, Ex. 20, 30 TTABVue. Since the brand first launched in the 1950's, the brand has become well-known among consumers for its high quality and distinctive taste, and has "cultivated something akin to a cult following... among whisky enthusiasts." *Maker's Mark Distillery, Inc. v. Diageo N. Am. Inc.*, 703 F.Supp.2d 671, 690-691, 97 USPQ2d 1780, 1792 (W.D. Ky. 2010), *aff'd*, 670 F.3d 410 (6th Cir. 2012). Opp. NOR 4, Ex. 20, 30 TTABVue.¹⁰ In 2019, Maker's Mark was awarded First Place in the "Best Bourbon Whiskey" category of the International Whiskey Competition. Phillips Decl. ¶31, Phillips Decl. Ex. 4, 31 TTABVue. And 42% of readers surveyed in an online poll by *Dayton Business Journal* in 2013 picked MAKER'S MARK as their favorite bourbon brand, with the second place finisher garnering less than half the votes MAKER'S MARK received. Opp. NOR 4, Ex. 15, 30 TTABVue.

¹⁰ In *Diageo*, the Sixth Circuit and Western District of Kentucky did not have the occasion to opine on the fame of the MAKER'S MARK trademark, as the trademark asserted and found to be infringed in *Diageo* was Opposer's trademark for the dripping red wax seal used on the MAKER'S MARK bottle, not any of Opposer's standard character marks asserted here.

According to leading market research firm Kantar Millward Brown, as of 2017, the year Applicant filed its application for BOWMAKER’S WHISKEY, bourbon represented 42% of all whiskey consumed in the United States, at least 69% of survey respondents were aware of the MAKER’S MARK brand, and MAKER’S MARK bourbon had consistently held a top-3 or top-4 spot in brand power for all whiskies in the United States, a field that includes bourbon as well as flavored, Irish, and other types of whiskey. *See* Phillips Decl. ¶¶19-27, Phillips Decl. Ex. 1. Moreover, a November 2018 article in *Food & Wine* magazine called MAKER’S MARK the #1 most important bourbon ever made, noting that it was “[t]he clear choice for the top spot” among those polled in its survey. Opp. NOR 4, Ex. 13, 30 TTABVue. The strength of the brand and widespread consumer awareness MAKER’S MARK has garnered has been evident for decades. Nearly a half century ago, in August 1980, MAKER’S MARK made the front page of the *Wall Street Journal*, where one observer noted that, by that point, the brand had already established “superior quality with a fine image” and was “a textbook case of superior marketing.” Opp. NOR 4, Ex. 14, 30 TTABVue.

But MAKER’S MARK’s reach is not limited to the spirits industry. The distillery where MAKER’S MARK bourbon was born and is made was designated a National Historic Landmark on January 25, 1980. Opp. NOR 5 Ex. 25, 34 TTABVue. In making this designation more than 40 years ago, the U.S. Secretary for the Department of the Interior noted that the distillery (i) “possesses national significance in illustrating the history of the United States,” (ii) “represents the evolution of bourbon from a relatively crude beverage . . . into a quality distillate recognized and readily accepted all over the world,” and is (iii) “[a] significant example of our Nation’s cultural heritage for the education and enjoyment of all our citizens.” *Id.* Attracting more than 100,000 visitors each year, Maker’s Mark’s distillery was the first in America to achieve historic landmark

status and has been decreed the world's "oldest operating bourbon whisky distillery" by *Guinness World Records*. Opp. NOR 5, Ex. 26, 34 TTABVue. It is a focal point for visitors to the Louisville, Kentucky area and has won the prestigious "Icons of Whisky Visitor Attraction of the Year" at least three times, twice back-to-back in the years immediately preceding Applicant's filing of the Contested Application. Opp. NOR 4, Ex. 17, 30 TTABVue; Phillips Decl. ¶¶32, 31 TTABVue. As noted by the Kentucky Distillers Association in January 2011, the MAKER'S MARK brand has transformed from a "Kentucky 'cult' bourbon into 'a national icon'". *Id.* Its broad sales channels and ambitious advertising campaigns have made MAKER'S MARK a familiar name among whiskey drinkers and non-drinkers alike.

c. Opposer's Sales of Bourbon under its MAKER'S MARK
Trademark Have Steadily Increased and are Higher Than Those
Associated with Other Marks Already Deemed Famous

Opposer's sales of MAKER'S MARK bourbon have climbed steadily over the years. For example, [REDACTED]

[REDACTED] Wagner Decl. Ex. 6, 35 TTABVue. These sales are made through a wide variety of trade channels, which include: (i) national and regional brick and mortar locations, such as liquor stores, grocery stores, and big-box chains, (ii) bars, pubs, restaurants and hotels, (iii) the Maker's Mark distillery gift shop in Loretto, Kentucky, (iv) caterers at sporting and music events and festivals, and (v) e-commerce, including third-party retailer websites and the Maker's Mark website, which drives sales online by directing customers to their local e-commerce delivery vendors. Wagner Decl. ¶¶17, 35 TTABVue.

The ubiquity of the MAKER'S MARK brand has been acknowledged by industry executives, including Applicant's own consultant. One beverage industry consultant and educator

was quoted in an article in *The Associated Press* as saying “You can’t run a bar without Maker’s”¹¹ and Applicant’s consultant Don Rodgers gave testimony that “everybody knows Maker’s Mark.”¹² According to figures from the Distilled Spirits Council of the U.S. cited in *Business Wire*, in 2004 MAKER’S MARK had a 77% share of the U.S. fine bourbon market. Opp. NOR 4, Ex. 18, 30 TTABVue. In April 2020, *Forbes* reported MAKER’S MARK bourbon was one of the top two bestselling bourbons on e-commerce site Drizly.com. Opp. NOR 4, Ex. 19, 30 TTABVue. It is unquestionably among the most well-recognized—if not the most well-recognized—bourbon brand in the United States, as acknowledged by veteran industry executives testifying on behalf of both parties to this proceeding. Phillips Decl. ¶33, 31 TTABVue; Rodgers Test. 41:11-23, 47 TTABVue.

Furthermore, as noted in Section V.B.1 above, [REDACTED] exceeds sales metrics for other marks deemed famous by the Board or its reviewing court. *See Bose*, 293 F.3d at 1371-72 (\$50 million in annual sales of ACCOUSTIC WAVE and WAVE speaker systems); *Nike*, 100 U.S.P.Q. 2d at 1026 (\$175 million in annual sales of JUST DO IT apparel and shoes); and *Nat’l Pork Bd.*, 96 U.S.P.Q. 2d at 1495-96 (no sales, as owner of the asserted mark was a trade association, not a seller of pork).

d. Opposer’s Marketing Investments in MAKER’S MARK Bourbon are Significant and Higher Than Those Associated With Other Marks Previously Deemed Famous

Whether a mark is “famous” involves analyzing the commercial strength of the mark and determining whether a significant segment of the relevant consuming public readily recognizes the mark. *See Palm Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1374-75, 73 U.S.P.Q.2d 1689, 1694 (Fed. Cir. 2005). The more extensively advertised the mark,

¹¹ Opp. NOR 4, Ex. 16, 30 TTABVue.

¹² Rodgers Test. 18:14, 47 TTABVue.

the more well-known it is likely to be and “the more likely it is that it will be confused with a similar mark used on similar or related goods.” 4 McCarthy on Trademarks and Unfair Competition § 24:49 (5th ed.) (quoting *McDonald's Corp. v. McKinley*, 13 U.S.P.Q.2d 1895, 1900, 1989 WL 274414, *6 (T.T.A.B. 1989).

From the 1980 cover piece in *The Wall Street Journal* referencing the company’s ambitious advertising dating back to the 1950s to the 2018 *Food and Wine* article calling MAKER’S MARK the most important bourbon ever made, the brand has long been renowned for its “superior” and “savvy” marketing. Opp. NOR 4 Exs. 13-14, 30 TTABVue. Maker’s Mark’s spending in connection with promoting MAKER’S MARK bourbon [REDACTED]

[REDACTED]. Phillips Decl. ¶¶46-47, Phillips Decl. Ex. 8. These significant investments, which are deployed in print, online, on television, through social media, on billboards, and in point of sale displays,¹³ have yielded the unparalleled levels of consumer loyalty and recognition that have made the brand famous. As previously noted, a brand study commissioned by Maker’s Mark and performed by an outside market research firm showed that at least 69% of consumers are familiar with the MAKER’S MARK brand. Phillips Decl. ¶¶19-27, Phillips Decl. Ex. 1, 31 TTABVue. The brand’s Facebook page has over 839,000 “likes” and over 817,000 followers, and the Twitter account affiliated with the brand has over 133,000 followers. Thousands of individuals have eagerly signed up as “Brand Ambassadors” in a unique and ambitious grassroots marketing initiative. Wagner Decl. ¶20.

Finally, as noted in Section V.B.1, Maker’s Mark’s [REDACTED] brand investment exceeds marketing expenditures for other marks deemed famous by the Board or its reviewing court. *See Bose*, 293 F.3d at 1371-72 (\$5 million in annual marketing for ACCOUSTIC WAVE

¹³ Wagner Decl. ¶7, Wagner Decl. Ex. 1, 35 TTABVue.

and WAVE); *Nat'l Pork Bd.*, 96 U.S.P.Q. 2d at 1495-96 (\$25 million in annual marketing for THE OTHER WHITE MEAT).

Opposer's MAKER'S MARK and MAKER'S trademarks are demonstrably famous and the relative strength or fame of the senior mark factor weighs squarely in Opposer's favor.

e. In Addition to its Fame and Commercial Strength, MAKER'S MARK is Also an Inherently or Conceptually Strong Mark

As discussed above, the market strength of the MAKER'S MARK trademark cannot be meaningfully challenged. The commercial strength of a mark rests on the extent to which "a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator"¹⁴ and (i) at least 69% of consumers are aware of Opposer's MAKER'S MARK brand, (ii) Applicant's own consultant has acknowledged that the MAKER'S MARK brand is a famous one that "everybody" knows, and (iii) the brand's metrics meet or exceed those of other trademarks previously deemed famous.¹⁵

But marks are also judged by their conceptual strength, based on the inherent nature of the mark itself. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014); MCCARTHY, § 11:80 ("[Conceptual strength] focuses on the inherent potential of the term at the time of its first use. [Commercial strength] evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another's use.").

Here, the trademark MAKER'S MARK was selected and adopted by Maker's Mark Distillery's founder, Bill Samuels, Sr., and his wife, Margie Samuels, and inspired by the unique

¹⁴ *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)).

¹⁵ Phillips ¶27, Phillips Dec. Ex. 1; Rodgers Test. 44:14-22 and 18:14; Section V.B.1 *supra*.

imprints used by pewter craftsmen. Opposer’s Responses to Applicant’s Interrogatory Nos. 1-2, App. NOR 1, Ex. 23. *See also* App. NOR 2 Ex. 35, 37 TTABVue (Merriam-Webster definition of “maker’s mark” as “the hallmark on a piece of English gold, silver, or plate denoting the person or firm responsible for its production.”). Although the term “maker” alone is a noun associated with “a person or thing that makes” or “a manufacturer,”¹⁶ “maker’s mark” is an obscure term of art within the fine metal industry. Although consumers today are most likely to associate the term “maker’s mark” with bourbon made by the Opposer because of the company’s significant brand investments and the relative obscurity of the metalwork industry in popular culture, during the 1950s when the mark was adopted for use in connection with bourbon, nothing about the term of art “maker’s mark” related in any way to the goods with which Opposer decided to use it.

This suggests that, conceptually, using MAKER’S MARK for whiskey at the time the Samuels family adopted the mark ranks high on the spectrum of inherent distinctiveness. As the MAKER’S MARK origin story demonstrates, at the time it was adopted, the trademark was “fanciful” in that it was “coined for the express purpose of functioning as a trademark” for bourbon whiskey and otherwise only functioned as an archaic term used within a specialized industry generally unfamiliar to buyers. MCCARTHY, § 11:4. Even if the Board were to determine that “maker’s mark” was a commonly used term at the time it was adopted, it would still have been an “arbitrary” mark in that it was a metalwork term randomly applied to bourbon. *Id.*

2. The Parties’ Respective Marks are Highly Similar

a. MAKER’S is the Dominant Element of Opposer’s Marks

Opposer’s Marks include MAKER’S MARK, MAKER’S, MAKER’S 46 and MAKER’S MARK PRIVATE SELECT. Opp. NOR 1 Exs. 1-4, 26 TTABVue. The common and dominant

¹⁶ Opp. NOR 5, Ex. 27, 34 TTABVue.

element is MAKER’S. *See Nina Ricci*, 889 F.2d at 1073 (finding RICCI was the “unifying” element of successful opposer’s marks, which included MADEMOISELLE RICCI, SIGNORICCI and CAPRICCI). The first term of a mark, here MAKER’S, is generally considered the dominant term because it is “most likely to be impressed upon the mind of a purchaser and remembered,” *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 U.S.P.Q.2d 1895, 1897 (TTAB 1988), and because consumers tend to shorten marks to the first term. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 25 U.S.P.Q.2d 1321, 1333 (TTAB 1992); *In re Abcor Development Corp.*, 588 F.2d 811, 816, 200 USPQ 215, 219 (CCPA 1978) (Rich, J., concurring: “the users of language have a universal habit of shortening full names — from haste or laziness or just economy of words”); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1819 (T.T.A.B. 2015) (“While Opposer’s beer was originally sold under the BUDWEISER brand, customers soon began to abbreviate the mark, calling for BUDWEISER beer just by the name ‘BUD.’”).

The fact that MAKER’S is the dominant element of the mark and that people routinely abbreviate MAKER’S MARK to MAKER’S is supported by statements made at trial by Applicant’s witnesses. For example, Applicant’s consultant Don Rodgers, who has decades of experience in the spirits industry, called “MAKER’S” (referring to MAKER’S MARK) one of the “biggies” when asked to recite what he believed to be the leading bourbon brands in the United States. Rodgers Test. 41:11-23, 47 TTABVue. He similarly did not hesitate when asked what a bartender would give someone who showed up at a bar and asked for “MAKER’S”.¹⁷ Applicant’s founder Mr. Parks provided similar testimony that if someone asked for “MAKER’S” at a bar, the only clarification that could potentially be warranted is specification as to “what varieties of

¹⁷ “Q: If I showed up at a bar in Frankfort, Kentucky, and asked for a Maker’s, what would they give me? A: Maker’s Mark.” Rodgers Test. 41:24-42:2, 47 TTABVue.

Maker's Mark they carry on the shelf" that the customer might be referring to.¹⁸ The source a consumer is expecting when requesting "MAKER'S" in a potentially crowded bar is always Maker's Mark, whether it be the company's flagship MAKER'S MARK brand or one of its MAKER'S-formative spin-offs. Mr. Rodgers's and Mr. Parks's acknowledgement of consumers' use of MAKER'S as shorthand for products sold by the Opposer lends support to the argument that MAKER'S is the dominant element for purposes of assessing the similarity of the parties' marks.

b. WHISKEY is the Weak Element of Applicant's BOWMAKER'S WHISKEY Mark and Should Be Given Little Weight

The court may place more weight on a dominant portion of a mark, for example, if another feature of the mark is descriptive or generic standing alone. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ("[T]here is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.").

Here, the Contested Application for BOWMAKER'S WHISKEY includes a disclaimer of the term WHISKEY since whiskey is a generic term for the distilled spirit by the same name identified as one of Applicant's claimed goods. Disclaimed terms are the weak portions of the parties' marks and "given little weight in reaching a conclusion on the likelihood of confusion." *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 U.S.P.Q.2d 1842, 1846 (Fed. Cir. 2000); *see also In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) ("DELTA," not the disclaimed generic term "CAFE," the dominant portion of the mark THE DELTA CAFE). Since WHISKEY simply describes the claimed good and is incapable of serving as a source identifier, the relevant consideration here is largely the similarities between, on the one hand, Opposer's

¹⁸ Parks Trial Test 52:22-53:16.

MAKER'S MARK and MAKER'S trademarks and, on the other hand, Applicant's use of BOWMAKER'S for identical goods sold through identical channels-of-trade.

c. When Comparing Standard Character Marks, the Parties' Manner of Use and the Origin of the Marks Are Irrelevant

Because the parties' marks are in standard characters, they "could be used in any typeface, color, or size, including the same stylization actually used . . . by the other party, or one that minimizes the differences or emphasizes the similarities between the marks." *Anheuser-Busch*, 115 USPQ2d at 1823 (citing *Citigroup II*, 98 USPQ2d at 1258-59).

Applicant's witnesses and even its attorney of record in this opposition seem to overlook this fact. For example:

- During redirect of Mr. Parks, counsel for the Applicant asked about Applicant's labels and intended manner of using the trademark BOWMAKER'S WHISKEY in an effort to distinguish Applicant's mark from Opposer's Marks. *See Parks Trial Test 75:12-17* ("Q: The wording [on the label], 'Bowmaker's Whiskey,' is that generally how you intend to use the trademark? A: Yes sir. Q: With a capital B and a capital S at the beginning and end of the word? A: Yes. And the archer as the A, yes, sir.")
- Mr. Rodgers also erroneously framed the question presented in this opposition as a comparison between a MAKER'S MARK bourbon bottle with a red wax seal and Applicant's planned logo, which it has not applied to register. *See Rodgers Test. 55:9-22* ("I mean, [MAKER'S MARK]'s a well-known brand, there's no doubting it . . . And Bowmaker's, that's why I wanted to see the label. I mean, there's no red wax—there's no wax on this—I don't even think [Applicant] has a bottle yet. [Applicant] just has a label, and it looks nothing like a Maker's Mark label. And

the way [Applicant]’s got ‘Maker’s’ spelled on it with a bow for the A, it’s not really clear that the name of it is Bowmaker’s to tell you the truth.”)

- Only Applicant’s former attorney, Ms. Khalsa, was able to make the distinction when shown the Applicant’s planned logo. (Q: [The Contested Application] was for BOWMAKER’S WHISKEY in standard characters alone; is that correct? . . .
A: Yes, this is a standard character mark. Q: And you don’t recall ever filing a trademark application to register a stylized version of BOWMAKER’S WHISKEY.
A: No, that’s a pretty distinctive mark. I probably would have remembered that one.”) Khalsa Test.33:9-34:6.

The relevant comparison here is between Applicant’s standard character mark and Opposer’s standard character marks, which share the identical dominant term MAKER’S. And “[t]o the average buyer, the points of similarity”—in this case the identical term MAKER’S—“are more important than minor points of difference.” 4 McCarthy on Trademarks and Unfair Competition § 23:41 (5th ed. 2018); *see also Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1914 (T.T.A.B. 2000) (“[E]ven if consumers were to notice the difference between [the marks], they might well think that this mark was a variant of [Opposer’s] mark.”). This is particularly true where, as here, Opposer has developed brand extensions with variants of MAKER’S out of its flagship MAKER’S MARK brand, namely MAKER’S MARK PRIVATE SELECT, MAKER’S 46 and MAKER’S MARK CASK STRENGTH.

When assessing similarity, the origins of a mark’s adoption are also irrelevant. For example, in *New Era Cap Co. Inc. v. Pro Era LLC*, Opposition No. 81216455, 2020 WL 2854282 (TTAB 2020), the applicant argued that the opposer’s NEW ERA mark was different in appearance, sound, connotation, and commercial impression due to inclusion of the word PRO in

applicant's PRO ERA mark and evidence that the term PRO ERA is an abbreviation for PROGRESSIVE ERA. Here, Applicant has similarly presented testimony that it adopted its mark because its founder has a hobby of making bows used for archery, hence the "BOW" in "BOWMAKER'S". However, in *New Era*, the Board adhered to its own precedent that "[t]he derivation of a mark is of no particular significance if the end result is a mark confusingly similar to a previously registered mark." *In re Iowa Paint Mfg. Co.*, 149 USPQ 230, 231 (TTAB 1966) (citing *Meyer Chem. Co. v. Anahist Co.*, 263 F.2d 344, 120 USPQ 483, 484 (CCPA 1959) ("How the mark came to be adopted is not material to the issue.")). Refusing to parse consumers' likely associations with the term "PRO," the Board ultimately refused registration of PRO ERA on the grounds that it was confusingly similar to opposer's NEW ERA mark. *New Era* 2020 WL 2854282 at 21.

Just as in *New Era*, the Board found the term "PRO" could symbolize "PROGRESSIVE," "PROFESSIONAL," or any number of other terms, so too, the term "BOW" could be equally symbolic of an archery tool, an implement used to play string instruments, or a ribbon tied to a birthday present. It is the perspective of the average consumer, who might view "BOWMAKER'S" as a brand extension of MAKER'S MARK or MAKER'S, not the subjective intent of the trademark owner as to the mark's meaning or significance, that matters. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975) ("In evaluating the similarities between marks, the emphasis must be on the recollection of the average purchaser who normally retains a general, rather than specific, impression of trademarks").

d. Level of Similarity Required is Diminished Because Products and Trade Channels are Identical

Less similarity is required for the similarity of marks factor to favor the opposer if the parties' goods are identical. *In re Viterra*, 671 F.3d 1358, 101 U.S.P.Q.2d 1905, 1908 (Fed. Cir.

2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 U.S.P.Q.2d 1698, 1700 (Fed. Cir. 1992). Here, Opposer's marks MAKER'S MARK and MAKER'S, on the one hand, and Applicant's mark BOWMAKER'S WHISKEY, on other hand, each incorporate the dominant portion of Opposer's famous MAKER'S MARK and MAKER'S trademarks in their entirety and, as discussed in Section V.E, are used for the same goods through same channels-of-trade. On balance, and with appropriate deference given to the senior user of a famous mark for directly competitive goods, the similarity of the marks in sight, sound and meaning factor also favors Opposer.

3. The Parties' Goods and Channels-of-Trade are Identical and Sales are Often Made in an Environment Easily Prone to Confusion

The Federal Circuit has held that "[t]here is no excuse for even approaching the well-known trademark of a competitor,"¹⁹ but that is exactly what Applicant has done by adopting BOWMAKER'S WHISKEY for identical goods sold through identical trade channels.

Because Applicant has not limited its marketing or trade channels in the Application, the Board must presume that Applicant promotes and sells its goods through all normal channels-of-trade for alcoholic beverages. *Schieffelin & Co. v. The Molson Companies Ltd.*, 9 U.S.P.Q.2d 2069, 2073 (TTAB 1989). These channels, which include liquor stores, restaurants, and bars, are easily prone to confusion. *Id.* (finding likelihood of confusion enhanced where, as here, "the products of the parties are of the type ordered verbally [orally] in bars and restaurants."). Approximately 40% of the time, Opposer's covered products are consumed on premise (*e.g.*, in a bar or restaurant). Phillips Decl. ¶27, Phillips Decl. Ex. 1, 31 TTABVue. These environments can be noisy and, particularly in the context of a bar, decisions are not always made based on careful review of a detailed menu. Furthermore, as previously discussed, consumers commonly abbreviate trademarks

¹⁹ *Nina Ricci*, 889 F.2d at 1074.

and shorten the names of their preferred beverages into what's known as a "bar call" when ordering at a bar or restaurant. Just as "BUD" is a famous trademark that started as a bar call for "BUDWEISER" and was later embraced in advertising for BUDWEISER beer,²⁰ "MAKER'S" is a famous trademark used as a bar call for "MAKER'S MARK" and embraced as a fixture of Maker's Mark's ad campaigns. Wagner Decl. ¶10. When taking an order in a loud bar, one could easily miss the first syllable of "BOWMAKER'S" and hear "MAKER'S" instead, particularly when the latter stands for a ubiquitous product some industry executives have said you "can't run a bar without".²¹

Applicant has acknowledged that it plans to sell its bourbon through many of the same channels Opposer testified that it sells MAKER'S-branded products. For example, Applicant testified that it has already begun marketing BOWMAKER'S at restaurants and through social media, engaged a distributor, is constructing a tasting room, and hopes to offer multiple varieties of BOWMAKER'S bourbon in liquor stores, bars and restaurants. Parks Trial Test 9:7-19; 16:10-17; 17:21-18:16; 22:23-23:14.

The similarity-of-goods, channels-of-trade and conditions-of-sale factors strongly weigh in Opposer's favor.

4. Opposer Stands Alone as User and Registrant of MAKER'S- Formative Marks For Whiskey or Bourbon

During its testimony period, Opposer submitted un rebutted evidence that no company besides Maker's Mark offers bourbon for sale in the U.S. using the term "MAKER" or "MAKER'S" in its name. *See* Phillips Decl. ¶60, 31 TTABVue; Wagner Decl. ¶26, 35 TTABVue.

²⁰ *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1823 (TTAB 2015).

²¹ Opp. NOR 4, Ex. 15, 30 TTABVue.

Although Applicant submitted numerous third-party registrations via Notice of Reliance during its own testimony period,²² the marks cited are a distraction, as they do not use the possessive term MAKER’S, which is the common feature of BOWMAKER’S and MAKER’S and the ultimate source of potential confusion.

During its rebuttal period, Opposer submitted a printout from the electronic records of the USPTO showing the 8 active applications and registrations in Class 33 that contain the word segment MAKERS in punctuated and non-punctuated form for the goods and services “whiskey,” “whisky,” or “bourbon.” Apart from the Contested Application and one registration for a design mark owned by an Italian winemaker whose product offerings are limited to wines, all of the marks returned in the search are owned by the Opposer. Opp. NOR 6 Exs. 30-35, 48 TTABVue. This evidence shows that, until now, Opposer has been the sole registrant and user of MAKER’S-formative marks for bourbon and whiskey. Given the fame of the MAKER’S MARK and MAKER’S trademarks, as discussed in Section V.B.1, there is “no excuse” for Applicant “even approaching” the well-known trademarks of its competitor, Maker’s Mark. *Nina Ricci*, 889 F.2d at 1073.

5. Evidence Suggesting Applicant May Have Intended to Infringe Further Cements a Likelihood of Confusion and Willingness to Trade on the Goodwill Associated with Opposer’s Marks

In addition, there is uncontroverted evidence that the Applicant copied marketing material from Opposer’s website in preparing itself for business, which suggests an intent to infringe. As noted above, Applicant’s first website design used nearly identical phrasing to Opposer’s website:

Opposer’s Website	Applicant’s Website
“ <u>We make our bourbon carefully. Please enjoy it</u> that way”	“ <u>We make our whiskey carefully. Please enjoy it</u> one shot at a time”

²² See App. NOR 2, Exs. 36-74, 37 TTABVue.

<u>“We’ve never been much for following the rules, but this one’s a must. You must be of legal drinking age to surf our web site.”</u>	<u>“We’ve never been much for following the rules, but this one’s a must. You must be of legal drinking age to surf our web site.”</u>
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Phillips Decl. Ex. 7, Jenkins Test. Ex. 5.

These facts are germane to the likelihood of confusion inquiry under at least the final *DuPont* factor. *DuPont*, 177 USPQ at 567 (listing “any other established fact probative of the effect of use” as a factor); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1742 (T.T.A.B. 1991) (“[A] party which knowingly adopts a mark similar to one used by another for the same or closely related goods or services does so at its peril”).

An intent to infringe can also be inferred from the ubiquity of the Opposer’s marketing and business presence in Mr. Parks’ geographic area. *See Autozone Inc., v. Strick*, 543 F.3d 923, 934, 88 USPQ2d 1225, 1232 (7th Cir. 2008) (holding that “a reasonable trier of fact could conclude from Strick’s experience in the industry, AutoZone’s extensive marketing of its mark in the area where defendant did business, and the close similarity in design between the marks, that Strick designed the Oil Zone mark with the intent to mislead consumers into believing that Oil Zone was somehow affiliated with AutoZone”).

Opposer’s MAKER’S brands are widely advertised and promoted in the same geographical area as the Applicant’s place of business and residence in Michigan. In fact, testimony showed that sales in Kalamazoo, Michigan; Portage, Michigan; Schoolcraft, Michigan; and Lake City, Michigan were [REDACTED]. Phillips Decl. ¶52. Along with Opposer’s extensive advertising and marketing campaigns, Opposer has used several noticeable point-of-sale displays in connection with MAKER’S MARK in the Kalamazoo, Michigan area and made substantial sales at the very store where Applicant’s founder

Mr. Parks frequently shops. See Parks Discovery Dep. 40:6-9 (acknowledging having shopped at Mega-Bev); Phillips Decl. ¶¶55-56 (identifying sales at Mr. Parks's local Mega-Bev store in the amounts of [REDACTED]). Mr. Parks acknowledges that, prior to founding Bowmaker's Whiskey Company, he had purchased MAKER'S MARK bourbon and attended a speech given by Bill Samuels, Jr., the former president and CEO of Maker's Mark Distillery, at which time he went out of his way to take a photograph with Mr. Samuels, Jr.. Parks Trial Test 18:20-24, 11:7-12:25, 13:16-14:25, 51:19-52:3.

Even if the Applicant acted innocently, at a minimum, it and its agents, a law firm that rubber stamps trademarks cleared by clerical workers in India and a non-attorney marketing consultant without knowledge of trademark law or the spirits industry, were "careless in not conducting a thorough name search for American uses of the name" that would have identified Opposer's Marks for identical competitive goods. *Fisons Horticulture, Inc. v. Vigoro Industries, Inc.*, 30 F.3d 466, 480, 31 USPQ2d 1592, 1602 (3rd Cir. 1994) (quoting *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 463 (3rd Cir. 1983)).

C. Any Doubt About Whether Confusion is Likely Should Be Resolved in Opposer's Favor

Although Opposer maintains that the evidence clearly supports barring Applicant from registering BOWMAKER'S WHISKEY for goods identical to those sold under Opposer's famous MAKER'S trademarks, to the extent there is any doubt, the precedent is clear that such doubts are to be resolved in favor of Opposer and its MAKER'S brands. *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 355, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992) ("In the event of doubts about the likelihood of confusion, the Board and this court should resolve those doubts against the newcomer.").

VI. CONCLUSION

Given that the goods are identical, directly competitive, and frequently sold in bars and restaurants where oral orders are taken and apt to be confused, the marks asserted by Opposer are exceedingly strong, if not famous, and the parties' respective marks are highly similar, Opposer respectfully requests that the Board sustain this Opposition on the grounds of likelihood of confusion under Section 2(d) and refuse registration to Applicant.

Dated: April 13, 2021

Respectfully submitted,

By: /s/ Richard M. Assmus
Michael D. Adams
Richard M. Assmus
Emily A. Nash
Daniel P. Virtue
MAYER BROWN LLP
P.O. Box 2828
Chicago, IL 60690-2828
(312) 701-8713

Attorneys for Opposer

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing Opposer's Opening Trial Brief, was served via email on counsel for Applicant at the following addresses on April 13, 2021:

THEODORE A BREINER
BREINER & BREINER LLC
115 NORTH HENRY STREET
ALEXANDRIA, VA 22314-2903
UNITED STATES
Docketclerk@bbpatlaw.com, tbreiner@bbpatlaw.com,
Elisedelatorre@bbpatlaw.com

/s/ Daniel P. Virtue
Daniel P. Virtue
Attorney
MAYER BROWN LLP

APPENDIX A
EVIDENTIARY OBJECTIONS

Pursuant to 37 C.F.R. § 2.128(b) and TBMP § 801.03, Opposer Maker's Mark Distillery, Inc. hereby submits the following evidentiary objections in connection with its opening trial brief.

A. Petitioner Failed to Timely Disclose its Counsel Theodore A. Breiner as a Witness, so the Breiner Declaration and Exhibits 87-98 Attached Thereto Should Be Stricken.

On December 29, 2020, at the close of Applicant's testimony period, Applicant filed the Declaration of Theodore A. Breiner, with exhibits 87-98 (the "Breiner Declaration"). 44 TTABVue. As noted in paragraph 1 of the Breiner Declaration, Mr. Breiner is counsel of record for the applicant in this opposition proceeding. Mr. Breiner was not named as a potential witness in Applicant's Initial Disclosures or in its Pretrial Disclosures. *See* Opp. NOR 3, Ex. 6; 29 TTABVue. Exhibits 87-98 to the Breiner Declaration include: (i) photos allegedly taken of Opposer's products on the shelves of a store in Virginia (Exs. 87-95), (ii) copies of Google search pages for "deity events" and "bowmaker's whiskey" (Exs. 96-97), and (iii) an alleged copy of the webpage located at www.bowmakerswhiskey.com as it was found by Mr. Breiner on December 29, 2020. Under 37 C.F.R. § 2.121(e) and TBMP 533.029(b), Applicant was required to name in its pretrial disclosures any witness, including Mr. Breiner, from whom it intended to take testimony, or even might take testimony if needed. Since Applicant did not, Opposer hereby moves to strike the testimony of Mr. Breiner and the accompanying exhibits to the Breiner Declaration in their entirety.

B. Exhibits 79 and 80 to Applicant's Third Notice of Reliance Should be Stricken as Improper Material for Submission via Notice of Reliance.

Exhibits 79 and 80 to Applicant's Third Notice of Reliance (43 TTABVue) contain alleged Google search results for "member's mark bourbon" and "members mark whiskey prices". However, "Internet search summaries, which essentially are links to the website pages, are not admissible by notice of reliance." TBMP § 704.08(b). *See also Edom Laboratories, Inc. v. Llichter*, 102 U.S.P.Q.2d 1546, (TTAB 2012) (finding Google search summary inadmissible). Because Exhibits 79 and 80 are not suitable for submission via Notice of Reliance, Opposer hereby moves to strike the Exhibits 79 and 80 to Applicant's Third Notice of Reliance in their entirety.